



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/526,796

01/10/2006

Ko Kaku

HO-P03144US0

7396

26271 7590 05/21/2009
FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

BEKKER, KELLY JO

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,796	Applicant(s) KAKU ET AL.	
	Examiner Kelly Bekker	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/21/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1794

DETAILED ACTION

Amendments made 2/21/09 have been entered.

Claims 1-15 remain pending.

Note: In the Remarks, page 10, applicant states that a readable copy of the Perry reference was not found in the file. A copy of the reference is included herein. If applicant continues to have problems with the clarity of the reference, applicant is encouraged to contact the examiner for further arrangements.

Drawings

The objections to the drawings because they include the following reference character(s) not mentioned in the description: Figure 2a reference character 2b and Figure 2b reference character 2c has been withdrawn in light of applicant's amendments made to the specification on February 21, 2009.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The 112 second paragraph rejection of claim 13 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in light of applicant's amendments and arguments made February 21, 2009.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The 102(b) rejection of claims 1-5, 7, 8, 10, and 12-14 as being anticipated by Murphy et al (US 5853788) has been withdrawn in light of applicant's amendments made February 21, 2009.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The 103(a) rejection of claims 9 and 15 as being unpatentable over Murphy et al (US 5853788) has been withdrawn in light of applicant's amendments made February 21, 2009.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al (US 5853788) in view of Perry et al (ed.) (Perry's Chemical Engineers' Handbook 7th Edition pages 20-82 through 20-84).

Murphy et al (Murphy) a process for the preparation of a coffee product comprising the steps of grinding a roasted coffee (column 5 lines 58-63), externally cooling the coffee prior to or during compressing (column 7 lines 40-48), compressing the coffee in a pellet mill with a profiled roller to form a compressed body of coffee (column 6 all), crushing the compressed coffee to form a particulate product (column 9 lines 14-17), and packaging the particulate coffee (column 8 lines 28-32). Murphy teaches that the coffee product is brewed (Column 9 lines 35 and 36). Murphy teaches that the press is a roller press as defined by applicant (specification page 2 lines 18-20) by teachings that apparatus compacts particulate materials into shaped products by compression against at least one roller (column 6 all). Murphy teaches that the tap density, i.e. the density of the agglomerated product, of the ground compressed tablet is 0.5-0.7gm/cc (column 7 lines 58-60). Regarding the particulate size of the coffee as recited in claim 12, as Murphy teaches that the volumetric particle size of the particulate coffee is from 270-1100um and the median volumetric size of the particulate is from 270-1100um (abstract), one of ordinary skill in the art would expect that the volume mean diameter also be within the range of 270-1100um as recited in claim 12. Regarding the density of the compressed coffee as recited in claim 7, since Murphy teaches of substantially the same processes of producing the pressed coffee as instantly claimed and since Murphy teaches that the compressed coffee crushed has substantially the same particle size as the instantly claimed crushed compressed coffee, one of ordinary skill in the art at the time the invention was made would expect that the

Art Unit: 1794

compressed coffee taught by Murphy inherently have the same properties, including density, as instantly claimed.

Murphy is silent to the roller press as comprising a pocketed roller as recited in claim 1, 10, 12, and 15, to the roller press as comprising a profiled roller as recited in claim 5, to the roller press as comprising two pocketed rollers as recited in claim 6, to the coffee as in a brewing capsule as recited in claims 9 and 15, and to the compressed tablets as not having opposed flat faces as recited in claim 11.

Perry et al (Perry) teaches that the roller press and pellet mill are both used to compress particulate materials together and form pellets (page 20-82 and 20-83). Perry teaches that the roller press can produce large quantities of materials at a low cost (page 20-82). Perry teaches that the roller press had two rollers with pockets or indentations in the roller surface (page 20-82). Parry teaches that the pockets and/or indentations form the shape of the pellets (page 20-82).

Regarding using a roller press with at least one, preferably two rollers with profiled or pocketed surfaces as forming the compressed coffee tablets, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a roller press comprising two rollers as the pellet mill as taught by Murphy in order to process large quantities of material at a low cost as taught by Perry. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to use profiled or pocketed rollers or a combination of both depending on the shape and texture of the final product desired. For example, one would have been motivated to use a pocketed roller to form a smoothly rounded final product; one would have been motivated to use a profiled roller to form a more textured final product; one would have been motivated to use a combination of a pocket and profiled roller to form a final product which was both smooth and textured. To do so would be obvious and within routine determination of one of ordinary skill in the art at the time the invention was made.

Regarding the coffee as in a brewing capsule, it would have been obvious to package the coffee product in a brewing capsule, so that the product could be easily brewed from the package. Since Murphy teaches that the coffee is packaged and

Art Unit: 1794

brewed, the use of a conventional package, such as a brewing capsule, would have been within the routine determination of one of ordinary skill in the art.

Regarding the compressed tablets as not having opposed flat faces, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the roller pockets to be in a rounded shape so that the pellets could be easily removed and pieces of the coffee would not get stuck in the corners of the pocket, thus forming compressed tablets with rounded corners, i.e. compressed tablets not having opposed flat faces. To do so would be common sense and within the routine determination of one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 7, 8-10 and 12-15 (remarks pages 7-9) have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments filed February 21, 2009.

Applicant's arguments with respect to claims 6 and 11 (remarks pages 10-11) have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some teaching, suggestion, or motivation found in the references themselves and in the

Art Unit: 1794

knowledge generally available to one of ordinary skill in the art. Perry et al (Perry) teaches that the roller press and pellet mill are both used to compress particulate materials together and form pellets (page 20-82 and 20-83); Perry teaches that the roller press can produce large quantities of materials at a low cost (page 20-82); Perry teaches that the roller press had two rollers with pockets or indentations in the roller surface (page 20-82). Parry teaches that the pockets and/or indentations form the shape of the pellets (page 20-82); thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a roller press comprising two rollers as the pellet mill as taught by Murphy in order to process large quantities of material at a low cost as taught by Perry; and based on the knowledge available to one of ordinary skill in the art, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to use profiled or pocketed rollers or a combination of both depending on the shape and texture of the final product desired. For example, one would have been motivated to use a pocketed roller to form a smoothly rounded final product; one would have been motivated to use a profiled roller to form a more textured final product; one would have been motivated to use a combination of a pocket and profiled roller to form a final product which was both smooth and textured.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1794

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Bekker whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Art Unit 1794

/Kelly Bekker/
Examiner
Art Unit 1794